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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,139	05/23/2000	Paul Lapstun	NPA019US	9190

24011 7590 10/18/2005

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/575,139

Applicant(s)

LAPSTUN ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on July 27, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25, 26, 28-33, 35-37, 39-45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-26, 28-33, 35-37, 39-45 and 47-49 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/27/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Quayle Action*

1. This application is in condition for allowance except for the following formal matters:

- claim 26 is dependent on a canceled claim 1.
- claim 33 is dependent on a canceled claim 8.
- claim 37 is dependent on a canceled claim 12.
- claim 39 is dependent on any one of canceled claims 12 to 14.
- claim 40 is dependent on a canceled claim 15.
- claim 41 is dependent on any one of canceled claims 15 or 16.
- claim 42 is dependent on any one of canceled claims 12 to 17.
- claim 43 is dependent on any one of canceled claims 12 to 18.
- claim 44 is dependent on a canceled claim 19.
- claim 45 is dependent on any one of canceled claims 19 or 20.
- claim 47 is dependent on any one of canceled claims 12 to 22.
- claim 48 is dependent on any one of canceled claims 12 to 23.
- claim 49 is dependent on a canceled claim 24.

Prosecution on the merits is closed in accordance with the practice under *Ex parte*

*Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

*Allowable Subject Matter*

2. Claims 25-26, 28-33, 35-37, 39-45, 47-49 are allowed.

The following is an examiner's statement of reasons for allowance: Claims 25-26, 28-33, 35-37, 39-45, 47-49 are allowable over the prior art of record because the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches a system and method of enabling composition of a facsimile by a user and delivery thereof comprising means of and steps for providing a form to the user wherein the form is printed onto at least one paper surface, and includes visible information relating to the user and at least one area for the user to enter a message, the at least one paper surface having invisible coded data indicative of an identity of the form and of the at least one area, wherein the visible information and the invisible coded data are printed substantially simultaneously and wherein at the time of printing a computer system associates the type and spatial extent of the coded data with the spatial extent of at least some of the visible information.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Conclusion*


3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. Gundjian et al (US Patent No. 6,106,110) discloses a secure thermal ink jet printing composition and substrate wherein the composition is clear and is invisible to an unaided human eye in visible light when printed on the substrate.
  - b. Kobayashi et al (US Patent No. 6,490,681) teaches a system that impartially performs the deletion of a visible mark and the embedding of an invisible mark.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday, Tuesday, Thursday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2626

October 13, 2005